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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/581,482  
Filing Date: March 21, 2007  
Appellant(s): HOFMAIR ET AL.

\_\_\_\_\_  
Donald R. Studebaker  
For Appellants

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed July 22, 2011, appealing from the Office action mailed February 17, 2011.

**(1) Real Party in Interest**

Examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

Examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

Claims 1, 3-7 and 10-16 are rejected and currently pending on Appeal.

**(4) Status of Amendments After Final**

Examiner has no comment on Appellants' statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

Examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

Examiner has no comment on Appellants' statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by Examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

**(7) Claims Appendix**

Examiner has no comment on the copy of the appealed claims contained in the Appendix to Appellants' brief.

**(8) Evidence Relied Upon**

5,982,284	BALDWIN	11-1999
4,626,311	TAYLOR	12-1986
WO 01/75843	TIRKKONEN	10-2001

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-5, 7, 10, 15, and 16 are rejected under 35 U.S.C. 103(a) as obvious over USPN 5,982,284 to Baldwin in view of USPN 4,626,311 to Taylor.

Regarding claims 1 and 4, Baldwin teaches a textile label featuring a base layer, a transponder arrangement including a chip and an antenna (Baldwin, Abstract, column 3 lines 6-51), the transponder arrangement being bonded to the base layer by a first adhesive layer, a second adhesive layer, and an additional layer including an upper label bonded to the remainder of the label by the second adhesive layer (Id., Figures 1, 3 and 4), wherein the chip is covered by the second adhesive layer and is sealed by the second adhesive layer (Id., Figures 1, 3 and 4; *see additionally* column 1 line 14 to column 2 line 59, column 3 line 52 to column 5 line 48). Baldwin teaches that the base layer is a textile base layer and the additional layer is a textile layer, as paper appears to be within the scope of a textile base layer, and as it is a non-woven structure made of fibers.

Regarding claims 1 and 4, Baldwin does not appear to specifically teach that the chip and antenna are sealed against environmental influences by the second adhesive layer and the first and second adhesive layers, wherein the first adhesive layer consists of a polyester adhesive. However, Taylor teaches a substantially similar anti-theft label which is attached to a garment, the security label comprising a security device between first and second fabric layers, wherein

the security device is encapsulated by thermoplastic material (Taylor, column 1 lines 7-11, column 1 line 65 to column 2 line 30, column 3 lines 15-68, column 4 lines 50-61, column 5 line 57 to column 6 line 12, column 6 lines 47-52). Taylor teaches that the thermoplastic material is preferably a thermoplastic polyester, which provides a fluid-tight seal, which isolates the security device from water and chemicals (Id., column 5 lines 57-68, column 6 lines 1-12, column 6 lines 47-52). Taylor teaches that the thermoplastic material additionally serves to attach the security device to a particular part of a cloth product (Id., column 3 lines 15-32). It would have been obvious to one of ordinary skill in the security label art at the time the invention was made to form the security label of Baldwin, wherein the adhesive layers comprise polyester adhesive layers which encapsulate and provide a fluid-tight seal around the transponder arrangement, as taught by Taylor, motivated by the desire of forming a conventional security label with materials known in the art as being predictably suitable for forming security labels which can be attached to garments, and which provide a fluid-tight seal to protect the security device from water and chemicals, and damage or rust.

Regarding claim 3, Baldwin teaches that the second adhesive layer extends over the entire transponder arrangement in a plane fashion (Baldwin, Figures 1-4).

Regarding claim 5, Baldwin teaches that the second adhesive layer consists of a hot-melt adhesive (Baldwin, column 3 line 58 to column 4 line 5).

Regarding claim 7, Baldwin teaches that the base layer features at least one of the group including graphic and alphanumeric symbols (Baldwin, column 1 lines 14-55).

Regarding claim 10, Baldwin teaches that the upper label features at least one of the group including graphic and alphanumeric symbols (Baldwin, column 1 lines 14-55).

Regarding claim 15, Baldwin teaches that the additional textile layer includes part of a garment (Baldwin, column 6 lines 11-19). Since the label is attached to a garment, the label including the additional textile layer appears to be within the scope of the claimed limitation as being part of a garment. Additionally, it would have been obvious to one of ordinary skill in the security label art at the time the invention was made to form the security label of the prior art combination, wherein the additional layer includes part of a garment, motivated by the desire of forming a conventional security label which is securely attached to a garment, such that the security label is integrally formed as part of a garment to ease in manufacturing, and such that the security label is difficult to remove.

Regarding claim 16, Baldwin teaches a garment featuring a label according to claim 1 (Baldwin, column 6 lines 11-15, claims 18-32).

3. Claims 6 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin in view of Taylor, as applied to claims 1, 3-5, 7, 10, 15, and 16 above, and further in view of WO 01/75843 to Tirkkonen.

Regarding claim 6, Baldwin teaches a radio frequency identification device including a foil antenna coil and an integrated circuit. However, Baldwin does not appear to teach that the antenna consists at least predominantly of copper. Since Baldwin is silent as to the composition of the radio frequency identification device, it would have been necessary and therefore obvious to look to the prior art for conventional compositions of radio frequency identification devices.

Tirkkonen provides this conventional teaching, showing that it is known in the identification label art to form a substantially similar identification label for use on garments, the

label comprising a transponder and multiple layers of adhesive, wherein the transponder comprises a radio frequency identification device formed from copper wire (Tirkkonen, page 1 line 1 to page 4 line 20, page 4 line 36 to page 8 line 13, Figures 1-8).

It would have been obvious to one of ordinary skill in the identification label art at the time the invention was made to form the identification label of the prior art, such that the foil antenna coil of the radio frequency identification device comprises copper, as taught by Tirkkonen, motivated by the desire of forming a conventional identification label formed from metals known in the art to be predictably suitable for radio frequency identification devices.

Regarding claims 11-14, the prior art combination teaches that the label may be applied to a product by conventional methods. However, the prior art combination does not appear to teach that the upper layer protrudes over the base layer on at least one side, that at least a portion of the region of the upper label that protrudes over the base layer can be separated from the remainder of the label, and that the region of the upper label that protrudes over the base layer is sewn and/or bonded to a garment. Since the prior art combination is silent as to the method of attaching the label to a garment, it would have been necessary and therefore obvious to look to the prior art for conventional methods of attaching labels to garments.

Tirkkonen provides this conventional teaching, showing that it is known in the identification label art to form a substantially similar identification label for use on garments, the label comprising a transponder and multiple layers of adhesive, wherein at least a portion of a textile layer protrudes over the remaining portion of the layer (as shown in Figures 5-7 of Tirkkonen), such that the label is attached at its edges by sewing gluing to a product (Tirkkonen, page 1 line 1 to page 4 line 20, page 4 line 36 to page 8 line 13, Figures 1-8).

It would have been obvious to one of ordinary skill in the identification label art at the time the invention was made to form the identification label of the prior art combination, such that a portion of a textile layer protrudes over the base layer to be sewn or glued to a garment, as taught by Tirkkonen, motivated by the desire of forming a conventional identification label with conventional attaching methods known in the art to be predictably suitable for attaching identification labels to products such as garments.

#### **(10) Response to Arguments**

- A. Rejection of claims 1, 3-5, 7, 10, 15, and 16 under 35 U.S.C. 103(a) as obvious over Baldwin in view of Taylor

Contrary to the current rejection, Appellants argue that, in applying Baldwin, Examiner repeatedly fails to be diligent in pointing out which specific features in Baldwin correspond specifically to Appellants' claimed features. Therefore, Appellants argue that the final Office Action is incomplete at least because of the lack of specificity as to how and which features of Baldwin are relevant to each and every claimed feature.

Regarding Appellants' arguments, Examiner respectfully disagrees. As set forth above, Baldwin teaches in, for example, Figure 1, a textile label featuring a base layer **12**, a transponder arrangement including a chip and an antenna **22** (Baldwin, Abstract, column 3 lines 6-51), the transponder arrangement being bonded to the base layer by a first adhesive layer **18**, a second adhesive layer **32**, and an additional layer including an upper label bonded to the remainder of the label by the second adhesive layer **36** (Id., Figures 1, 3 and 4), wherein the chip is covered by the second adhesive layer and is sealed by the second adhesive layer (Id., Figures 1, 3 and 4; *see*

*additionally* column 1 line 14 to column 2 line 59, column 3 line 52 to column 5 line 48).

Baldwin teaches that the base layer is a textile base layer and the additional layer is a textile layer, as paper appears to be within the scope of a textile base layer, and as it is a non-woven structure made of fibers.

Appellants argue that the claimed textile label having a chip covered by the second adhesive layer and antenna which lacks an adhesive-free region or an air gap is clearly different from Baldwin. Examiner respectfully disagrees. The claimed invention only requires that the chip is covered by the second adhesive layer and is sealed by the second adhesive layer against environmental influences and that the antenna is sealed against the environmental influences by the first and second adhesive layer. As set forth above, Baldwin teaches a transponder located between first and second adhesive layers. Additionally, Taylor teaches a substantially similar anti-theft label which is attached to a garment, the security label comprising a security device between first and second fabric layers, wherein the security device is encapsulated by thermoplastic material (Taylor, column 1 lines 7-11, column 1 line 65 to column 2 line 30, column 3 lines 15-68, column 4 lines 50-61, column 5 line 57 to column 6 line 12, column 6 lines 47-52). Taylor teaches that the thermoplastic material is preferably a thermoplastic polyester, which provides a fluid-tight seal, which isolates the security device from water and chemicals (*Id.*, column 5 lines 57-68, column 6 lines 1-12, column 6 lines 47-52). Taylor teaches that the thermoplastic material additionally serves to attach the security device to a particular part of a cloth product (*Id.*, column 3 lines 15-32). It would have been obvious to one of ordinary skill in the security label art at the time the invention was made to form the security label of Baldwin, wherein the adhesive layers comprise polyester adhesive layers which

encapsulate and provide a fluid-tight seal around the transponder arrangement, as taught by Taylor, motivated by the desire of forming a conventional security label with materials known in the art as being predictably suitable for forming security labels which can be attached to garments, and which provide a fluid-tight seal to protect the security device from water and chemicals, and damage or rust.

It should be noted that Appellants are entitled to be their own lexicographer and may rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meanings. See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). Where an explicit definition is provided by Appellants for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999).

It appears that Appellants are attempting to provide further meaning to the disclosure beyond that which was originally present at the time of the filing, and attempting to establish a distinction and thus patentability of the claimed invention over that of the prior art, based upon this new interpretation. However, this is not proper. Appellants are not entitled to arbitrarily select a limiting definition or set of circumstances after the filing date, when the phrase in fact does encompass more than one interpretation or definition. It appears clear from the record that Appellants had no intention of interpreting or limiting the phrase “sealed” in such a manner. Appellants' specification does not define “sealed” as necessarily comprising a specific structure, such as hermetically sealing or sealing on all sides, such that an adhesive-free region or an air gap is necessarily not within the scope of “sealed.”

Appellants argue that Taylor fails to teach a textile base layer and an additional textile layer, or a chip and antenna transponder arrangement. Examiner respectfully disagrees. Taylor is not relied on to teach the claimed textile base layer and an additional textile layer, or a chip and antenna transponder arrangement. Taylor is relied on to teach a substantially similar anti-theft label which is attached to a garment, the security label comprising a security device between first and second fabric layers, wherein the security device is encapsulated by thermoplastic material. Taylor teaches that the thermoplastic material is preferably a thermoplastic polyester, which provides a fluid-tight seal, which isolates the security device from water and chemicals. Taylor teaches that the thermoplastic material additionally serves to attach the security device to a particular part of a cloth product. Therefore, it would have been obvious to one of ordinary skill in the security label art at the time the invention was made to form the security label of Baldwin, wherein the adhesive layers comprise polyester adhesive layers which encapsulate and provide a fluid-tight seal around the transponder arrangement, as taught by Taylor, motivated by the desire of forming a conventional security label with materials known in the art as being predictably suitable for forming security labels which can be attached to garments, and which provide a fluid-tight seal to protect the security device from water and chemicals, and damage or rust.

Appellants argue that Appellants' second adhesive layer further distinguishes from the adhesive layer 32 of Baldwin at least because the adhesive layer of Baldwin does not extend over chip 52 and antenna 53 in a plane fashion. Examiner respectfully disagrees. The structure of the claimed second adhesive layer is not limited to a plane fashion. Therefore, Appellants' arguments are not commensurate in scope with the final rejection.

Appellants argue that, with respect to claim 10, none of the drawings in Baldwin show a label attached to the paper sheet **12**. Examiner respectfully disagrees. Claim 10 is directed to the claimed upper label featuring at least one of the group including graphic and alphanumeric symbols. As set forth above, Baldwin teaches that the upper label features at least one of the group including graphic and alphanumeric symbols (Baldwin, column 1 lines 14-55). Claim 10 does not require the claimed label attached to a paper sheet. Therefore, Appellants' arguments are not commensurate in scope with the claims.

B. Rejection of claims 6 and 11-14 under 35 U.S.C. 103(a) as obvious over Baldwin in view of Taylor and further in view of Tirkkonen

Contrary to the current rejection, Appellants argue that Tirkkonen does not deal with the sealing of a chip within a label, much less sealing with two adhesive layers. Examiner respectfully disagrees, as Tirkkonen is not relied on to teach the claimed sealing of the transponder arrangement by the adhesive layers. Tirkkonen is relied on to teach the composition of the radio frequency identification device, as Tirkkonen teaches a substantially similar identification label for use on garments, the label comprising a transponder and multiple layers of adhesive, wherein the transponder comprises a radio frequency identification device formed from copper wire. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As set forth above, Baldwin in view of Taylor teaches the claimed adhesive layers and sealing

the transponder arrangement as claimed. Therefore, Appellants' arguments are not commensurate in scope with the final rejection.

Additionally, Tirkkonen teaches that the identification labels may comprise an identification (RFID) circuit (*see for example* Tirkkonen, page 1 lines 8-16) and forming the label from damage caused by heat and moisture using an adhesive (Id., page 3 lines 4-13). Additionally, as shown in at least Figure 2 of Tirkkonen, the label comprises a chip within a label.

Appellants argue that the use of a foil is mandatory in combination with a label according to Tirkkonen. Examiner respectfully disagrees. Tirkkonen does not teach a foil. Therefore, Appellants' arguments are not commensurate in scope with the teachings of Tirkkonen.

Appellants argue that manufacture of the antenna of the chip disclosed by Tirkkonen would not be realizable if a textile label were to be disposed as the back film, since electroconductive ink could not be printed on a textile label so as to form an antenna for a RFID chip, and therefore, Tirkkonen appears to teach away from the use of a textile upper layer. Examiner respectfully disagrees. Tirkkonen does not appear to teach away from the use of a textile upper layer, as Tirkkonen does not teach that a copper antenna cannot be used in conjunction with a textile upper layer.

Additionally, the use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain. A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred

embodiments, MPEP 2123. Tirkkonen is not relied on to teach electroconductive ink or electroconductive ink in combination with the prior art references.

Additionally, Appellants' arguments directed to the inability to print electroconductive ink on a textile label is not commensurate in scope with the final rejection. Tirkkonen is relied on to teach that it was known in the identification label art to form a substantially similar identification label for use on garments, the label comprising a transponder and multiple layers of adhesive, wherein the transponder comprises a radio frequency identification device formed from copper wire (Tirkkonen age 1 line 1 to page 4 line 20, page 4 line 36 to page 8 line 13, Figures 1-8). Therefore, it would have been obvious to one of ordinary skill in the identification label art at the time the invention was made to form the identification label of the prior art combination, such that the foil antenna coil of the radio frequency identification device comprises copper, as taught by Tirkkonen, motivated by the desire of forming a conventional identification label formed from metals known in the art to be predictably suitable for radio frequency identification devices.

Appellants argue that there is no second adhesive layer or upper label found in Tirkkonen. Examiner respectfully disagrees. Tirkkonen is relied on to teach the composition of the radio frequency identification device, as Tirkkonen teaches a substantially similar identification label for use on garments, the label comprising a transponder and multiple layers of adhesive, wherein the transponder comprises a radio frequency identification device formed from copper wire. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As set forth above, Baldwin in view of Taylor teaches the claimed adhesive layers and upper label. Therefore, Appellants' arguments are not commensurate in scope with the final rejection.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by Examiner in the Related Appeals and Interferences section of this Examiner's Answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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